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OFFICE OF PETITIONS

In re Application of :
Barr :
Application No. 09/927,433 : ON PETITION
Filed: August 10, 2001 :
For: MODULAR PACKAGE SYSTEM WITH BELT :
AND LEG BAGS :

This is a decision on the petition filed April 11, 2005, which is being treated as a petition under 37 CFR 1.181 to withdraw the holding of abandonment. The delay in treating this petition is regretted.

The petition considered under 37 CFR 1.181 is **granted**.

This application apparently became abandoned by operation of 35 U.S.C. § 151 for failure to pay the issue fee on or before October 22, 1995, as required by the Notice of Allowance and Issue Fee Due ("Notice") mailed July 22, 2004, which set a statutory period of three months within which to pay the fee to avoid abandonment. A Notice of Abandonment was not mailed. February 29, 1996.

Petitioner request that the holding of abandonment be withdrawn due to non receipt of a supplemental Notice of Allowance that petitioner expected would be mailed along with a supplemental Notice of Allowability containing additional post-allowance amendment to claim 5.

it is noted that a Notice of Allowability makes no reference to payment of the issue fee; that matter is treated by the Notice of Allowance. Petitioner's contention that he was prudent in expecting, and delaying payment of the issue fee until, the mailing a second Notice of Allowance has no basis in USPTO practice. Petitioner appears unaware of relevant USPTO policy noted in 1056 *Off. Gaz.* 35 (June 12, 1985) reproduced below:

ERRORS IN THE NOTICE OF ALLOWANCE

The purpose of this notice is to clarify existing Office practice with respect to providing a new issue fee due date. Sometimes errors appear in the Notice of Allowance, such as an incorrect number of claims, the misspelling of an inventor's name, an incorrect inventorship, or an incorrect title. A duplicate Notice of Allowance correcting the errors may be requested from the Group that mailed the Notice. However, a new issue fee due date will not be provided if the information on the original Notice of Allowance is sufficient to allow a reasonable practitioner to timely file a proper issue fee in the correct application. Specifically, the mere filing of a request for a corrected or duplicate Notice of Allowance will not act to stay the period for paying the issue fee.

Accordingly the holding of abandonment is not being withdrawn based on the reasons given in the petition, which do not allege non receipt of the first and only notice of allowance. Rather petitioner contends the case is not abandoned based non receipt of the Notice that petitioner assumes albeit incorrectly, should have been forthcoming and was in fact never mailed. The petition tacitly admits petitioner's awareness of the existence of the first and only Notice of Allowance, but fails to demonstrate as required by *Delgar, Inc. v. Schuyler*, 172 USPQ 513 (D.D.C. 1971), that the Notice mailed July 22, 2004, was not received. It is noted that

petitioner's last communications to the USPTO reflect a different address prior to the mailing of the Notices, but no effort was made to call USPTO attention to the fact of a change in correspondence address. For future reference, petitioner should timely remit the issue fee regardless of any other issues to avoid a holding of abandonment for failure to reply. A change in correspondence address is to be promptly and conspicuously brought to the attention of the USPTO, a circumstance that did not happen here.

Inspection of the record reveals that on August 4, 2004, the USPS returned to the USPTO the Notices of Allowance and Allowability mailed July 22, 2004, as undeliverable. Thus, another government agency has provided, on the record, independent corroboration of petitioner's non receipt of the Notices mailed July 22, 2004. See Ex Parte Gourtoff, According to MPEP 707.13 when, as here, the Office action of July 22, 2004, was returned as undeliverable to counsel by the USPS, the examiner was to take "every reasonable means" to ascertain the correct correspondence address, and remail the Office action to that address, rather than to hold the application abandoned for failure to reply to the prior mailing. § 707.13 further indicates that the period for reply is restarted by the remailing. As such, predicated or maintaining the holding of abandonment on the failure to reply to the Notice of July 22, 2004, is inconsistent with the practice set forth in MPEP 707.13 under the facts of this case. Accordingly, any holding of abandonment is improper and cannot be permitted to stand. Had the record failed to show return of the Notices as undeliverable, the holding of abandonment would not have been withdrawn.

The \$130 fee has been credited to counsel's deposit account as no fee is due for a petition under 37 CFR 1.181.

The instant application is being referred to the attention of the Technology Center for remailing the Notice of Allowance mailed July 22, 2004, returned as undeliverable, and resetting therein the 3 month period for reply. The Notice of Allowability mailed July 22, 2004 will also be remailed and the 3 month period for reply restarted.

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.



Brian Hearn
Petitions Examiner
Office of Petitions